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FISH & RICHARDSON, P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
CONTINO, PAUL F	

ART UNIT	PAPER NUMBER
2114	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/815,059	WU, YUH-CHERNG	
	Examiner	Art Unit	
	Paul Contino	2114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 4 is objected to because of the following informalities: line 2 should state multiples "procedures". Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 14-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 14-21 are not limited to tangible embodiments. In view of Applicant's disclosure, Specification page 33 lines 16-18, the system is not limited to tangible embodiments, instead being defined as including both nonspecific tangible embodiments (e.g. machine-readable storage device) and intangible embodiments (e.g. propagated signal). As such, the claims are not limited to statutory subject matter and are therefor non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by (WO 01/18652).

As in claim 1, Cha et al. discloses a method of performing diagnosis in a computer system *(page 8 lines 23-24)*, the method comprising:

receiving in a computer system executable program instructions that, when executed, cause the computer system to perform a first user-developed automated diagnostic procedure that either fails or passes depending on at least one condition in the computer system *(page 11 lines 2-14, where the baseline is interpreted as a an exemplary condition; page 15 line 24 discloses user-developed diagnostics)*, the computer system having stored therein a program 1) that, when executed, performs a plurality of preconfigured automated diagnostic procedures *(column 5 lines 6-7 and lines 18-19, where the diagnostic pull-down menu is interpreted as containing preconfigured diagnostics)* and 2) that is configured to accept user-developed automated diagnostic procedures *(page 15 lines 23-28)*; and

executing the program in the computer system and in so doing performing the plurality of preconfigured automated diagnostic procedures and the first user-developed automated diagnostic procedure *(pages 14 and 15)*.

As in claim 2, Cha et al. discloses the user-developed automated diagnostic procedure comprises at least one selected from the group consisting of: an application based automated diagnostic procedure and a content based automated diagnostic procedure *(page 14 lines 18-29, where real-time data are interpreted as application based and pseudo-static information are interpreted as content based)*.

As in claim 3, Cha et al. discloses the user-developed automated diagnostic procedure is a Business Add-In component *(page 15 lines 23-28, where the expandable diagnostic editing is interpreted as a Business Add-In component)*.

As in claim 4, Cha et al. discloses the plurality of preconfigured automated diagnostic procedure[s] are Business Add-In components *(page 14 lines 12-21, where the diagnostic transaction unit and diagnostic group are interpreted as Business Add-In components)*.

As in claim 14, Cha et al. discloses a computer program product tangibly embodied in an information carrier, the computer program product including instructions that, when executed, cause a processor to perform operations including:

receive in a computer system executable program instructions that, when executed, cause the computer system to perform a first user-developed automated diagnostic procedure that either

fails or passes depending on at least one condition in the computer system *(page 11 lines 2-14, where the baseline is interpreted as a an exemplary condition; page 15 line 24 discloses user-developed diagnostics)*, the computer system having stored therein a program 1) that, when executed, performs a plurality of preconfigured automated diagnostic procedures *(column 5 lines 6-7 and lines 18-19, where the diagnostic pull-down menu is interpreted as containing preconfigured diagnostics)* and 2) that is configured to accept user-developed automated diagnostic procedures *(page 15 lines 23-28)*; and

execute the program in the computer system and in so doing performing the plurality of preconfigured automated diagnostic procedures and the first user-developed automated diagnostic procedure *(pages 14 and 15)*.

As in claim 15, Cha et al. discloses the user-developed automated diagnostic procedure is a Business Add-In component *(page 15 lines 23-28, where the expandable diagnostic editing is interpreted as a Business Add-In component)*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cha et al. in view of Jackson et al. (U.S. PGPub 2004/0078692).

As in claim 5, Cha et al. teaches of a plurality of diagnostics. However, Cha et al. fails to teach of an installation automated diagnostic procedure. Jackson et al. teaches of an installation automated diagnostic procedure *(paragraphs [0028]-[0031])*.

It would have been obvious to a person skilled in the art at the time the invention was made to have included the installation automated diagnostics as taught by Jackson et al. in the invention of Cha et al. This would have been obvious because the inclusion of automated installation diagnostics as taught by Jackson et al. reduce the time and resources necessary to test a computer system *(paragraph [0003])*.

* * *

5. Claims 6, 10, 11, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cha et al. in view of Weinberg et al. (U.S. PGPub 2003/0131290).

As in claim 6, Cha et al. teaches of user-developed diagnostics. However, Cha et al. fails to teach of a response to a failure in the diagnostics. Weinberg et al. teaches of an advisory, warning, informational message, fatal error notification, and/or combination thereof *(paragraphs [0097] and [0099], where the status indicator is interpreted as an advisory, warning, informational message, fatal error notification, and/or combination thereof)*.

It would have been obvious to a person skilled in the art at the time the invention was made to have included the fault response as taught by Weinberg et al. in the invention of Cha et al. This would have been obvious because the inclusion of a fault response as taught by Weinberg et al. allows a user to know that there has been a problem with diagnostic testing, such as that taught by Cha et al.

As in claim 10, Cha et al. teaches of diagnostic procedures and the limitations of claim 1. However, Cha et al. fails to teach of ordering of diagnostic procedures. Weinberg et al. teaches of receiving priority information specifying an order in which the plurality of preconfigured automated diagnostic procedures is to be performed in the computer system *(paragraphs [0060], [0064], and [0069], where the predefined tree steps are interpreted as preconfigured diagnostic procedures)*; and

performing the plurality of preconfigured automated diagnostic procedures in the specified order *(paragraphs [0060], [0064], and [0069])*.

It would have been obvious to a person skilled in the art at the time the invention was made to have included the diagnostic ordering as taught by Weinberg et al. in the invention of Cha et al. This would have been obvious because the invention of Weinberg et al. allows for customizable design of diagnostics in order to best define a test suite to a particular system to be tested *(paragraph [0009])*. Further, the invention of Weinberg et al. is used for testing in an SAP R/3 system *(paragraph [0040])*, such as the system that Cha et al. is implemented in *(page 4 lines 17-18 and page 7 line 8)*.

As in claim 11, the combined in invention of Cha et al. and Weinberg et al. teaches of receiving user input regarding where in relation to the specified order to perform the user-developed automated diagnostic procedure *(Weinberg et al.: paragraph [0074] user insertion of a verification step; Cha et al.: page 15 line 24 discloses user-developed diagnostics)*.

As in claim 19, Cha et al. teaches of diagnostic procedures and the limitations of claim 14. However, Cha et al. fails to teach of ordering of diagnostic procedures. Weinberg et al. teaches of receiving priority information specifying an order in which the plurality of preconfigured automated diagnostic procedures is to be performed in the computer system *(paragraphs [0060], [0064], and [0069], where the predefined tree steps are interpreted as preconfigured diagnostic procedures)*; and

performing the plurality of preconfigured automated diagnostic procedures in the specified order *(paragraphs [0060], [0064], and [0069])*.

It would have been obvious to a person skilled in the art at the time the invention was made to have included the diagnostic ordering as taught by Weinberg et al. in the invention of Cha et al. This would have been obvious because the invention of Weinberg et al. allows for customizable design of diagnostics in order to best define a test suite to a particular system to be tested *(paragraph [0009])*. Further, the invention of Weinberg et al. is used for testing in an SAP R/3 system *(paragraph [0040])*, such as the system that Cha et al. is implemented in *(page 4 lines 17-18 and page 7 line 8)*.

As in claim 21, the combined in invention of Cha et al. and Weinberg et al. teaches of receiving user input regarding where in relation to the specified order to perform the user-

developed automated diagnostic procedure *(Weinberg et al.: paragraph [0074] user insertion of a verification step; Cha et al.: page 15 line 24 discloses user-developed diagnostics)*.

* * *

6. Claims 7-9 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cha et al. in view of Bajpai et al. (WO 97/15009).

As in claim 7, Cha et al. teaches the limitations of claim 1. However, Cha et al. fails to teach of remedy procedures. Bajpai et al. teaches causing a computer system to perform a user-developed automated remedy procedure that is associated with the user-developed automated diagnostic procedure *(page 7 lines 14-16, where correction of a problem is interpreted as a remedy)*.

It would have been obvious to a person skilled in the art at the time the invention was made to have included the remedy procedures as taught by Bajpai et al. in the invention of Cha et al. This would have been obvious because the invention of Bajpai et al. offers a diagnostic system which offers corrections of problems for a wide array of computer systems which are updatable, and reduce the necessity of human intervention *(page 2 lines 4-12)*.

As in claim 8, the combined invention of Cha et al. and Bajpai et al. teaches of a troubleshooting procedure designed to identify a problem source that may cause the user-developed automated diagnostic procedure to fail *(Bajpai et al.: page 7 lines 11-16, where the status of a digital data processor is indicative of a problem source)*.

As in claim 9, the combined invention of Cha et al. and Bajpai et al. teaches that the user-developed automated remedy procedure is designed to remedy a problem that may cause the user-developed automated diagnostic procedure to fail *(Bajpai et al.: page 7 lines 14-16)*.

As in claim 16, Cha et al. teaches the limitations of claim 14. However, Cha et al. fails to teach of remedy procedures. Bajpai et al. teaches causing a computer system to perform a user-developed automated remedy procedure that is associated with the user-developed automated diagnostic procedure *(page 7 lines 14-16, where correction of a problem is interpreted as a remedy)*.

It would have been obvious to a person skilled in the art at the time the invention was made to have included the remedy procedures as taught by Bajpai et al. in the invention of Cha et al. This would have been obvious because the invention of Bajpai et al. offers a diagnostic system which offers corrections of problems for a wide array of computer systems which are updatable, and reduce the necessity of human intervention *(page 2 lines 4-12)*.

As in claim 17, the combined invention of Cha et al. and Bajpai et al. teaches of a troubleshooting procedure designed to identify a problem source that may cause the user-developed automated diagnostic procedure to fail *(Bajpai et al.: page 7 lines 11-16, where the status of a digital data processor is indicative of a problem source)*.

As in claim 18, the combined invention of Cha et al. and Bajpai et al. teaches that the user-developed automated remedy procedure is designed to remedy a problem that may cause the user-developed automated diagnostic procedure to fail *(Bajpai et al.: page 7 lines 14-16)*.

* * *

7. Claims 12, 13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cha et al. in view of Weinberg et al., further in view of Bajpai et al.

As in claim 12, the combined invention of Cha et al. and Weinberg et al. teaches the limitations of claim 10. However, the combined invention of Cha et al. and Weinberg et al. fails to teach of updating priority information. Bajpai et al. teaches of updating priority information *(page 9 lines 26-27, where new problem-solution databases, which the decision test trees are developed from, are interpreted as priority information updates)*.

It would have been obvious to a person skilled in the art at the time the invention was made to have included the updating as taught by Bajpai et al. in the combined invention of Cha et al. and Weinberg et al. This would have been obvious because the invention of Bajpai et al. offers a diagnostic system which offers corrections of problems for a wide array of computer systems which are updatable, and reduce the necessity of human intervention *(page 2 lines 4-12)*.

As in claim 13, the combined invention of Cha et al., Weinberg et al., and Bajpai et al. teaches of publishing updated priority information *(Weinberg et al.: paragraph [0126], where the testscript tree representation is interpreted as published priority information)*.

As in claim 20, the combined invention of Cha et al. and Weinberg et al. teaches the limitations of claim 19. However, the combined invention of Cha et al. and Weinberg et al. fails to teach of updating priority information. Bajpai et al. teaches of updating priority information *(page 9 lines 26-27, where new problem-solution databases, which the decision test trees are developed from, are interpreted as priority information updates)*.

It would have been obvious to a person skilled in the art at the time the invention was made to have included the updating as taught by Bajpai et al. in the combined invention of Cha et al. and Weinberg et al. This would have been obvious because the invention of Bajpai et al. offers a diagnostic system which offers corrections of problems for a wide array of computer systems which are updatable, and reduce the necessity of human intervention *(page 2 lines 4-12)*.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent 6,134,644 Mayuzumi et al. discloses order diagnostics.

U.S. Patent 6,834,363 Austen et al. discloses remedy procedures.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Contino whose telephone number is (571) 272-3657. The examiner can normally be reached on Monday-Friday 9:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Baderman can be reached on (571) 272-3644. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PFC
11/27/2006

SCOTT BADERMAN
SUPERVISORY PATENT EXAMINER